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EXAMINER

LEE, PHILIP C

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,861

Applicant(s)

TAMURA, HIROSHI

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/23/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-58 are presented for examination.

Claim Rejections – 35 USC 112

2. Claims 1-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Claim language in the following claims is not clearly understood:
 - i. As per claim 1, line 3, it is unclear what is meant by “image information” (i.e. Does it mean text describing an image, image, or image file?)
 - ii. As per claims 4, 13, 22, 31, 40, 49, line 2, it is unclear what is “MDN” (i.e. please expand on abbreviation).
 - iii. As per claims 5, 14, 23, 32, 41, 50, line 2, it is unclear what is “DSN” (i.e. please expand on abbreviation).
 - iv. As per claims 8, line 3, it is uncertain what is meant by “a number of a page” (i.e. Does it mean page number?).

- v. As per claims 9 (line 3), 17 (lines 2-3), 18 (line 2), 26 (line 3), 27 (line 3), 35 (lines 2-3), 36 (line 3), 44 (line 3), 45 (line 3), 53 (lines 2-3) and 54 (line 3), they have the same uncertainty as in claim 8, line 3 above.
- vi. As per claims 10 (line 4), 19 (line 4), 28 (line 6), 37 (line 4), 46 (line 6), 55 (lines 8-9) and 56 (lines 10-11), they have the same uncertainty as in claim 1, line 3 above.
- vii. As per claims 2-9, line 1, it is unclear if “A method” refers to “A method” in claim 1, line 1 [i.e. if they are the same, then “The method” must be used].
- viii. As per claims 11-18, line 1, it is unclear if “A method” refers to “A method” in claim 10, line 1 [i.e. if they are the same, then “The method” must be used].
- ix. As per claims 20-27, line 1, it is unclear if “A data terminal” refers to “A data terminal” in claim 19, line 1 [i.e. if they are the same, then “The data terminal” must be used].
- x. As per claims 29-36, line 1, it is unclear if “A data terminal” refers to “A data terminal” in claim 28, line 1 [i.e. if they are the same, then “The data terminal” must be used].
- xi. As per claims 38-45, line 1, it is unclear if “A data terminal” refers to “A data terminal” in claim 37, line 1 [i.e. if they are the same, then “The data terminal” must be used].

xii. As per claims 47-54, line 1, it is unclear if “A data terminal” refers to “A data terminal” in claim 46, line 1 [i.e. if they are the same, then “The data terminal” must be used].

xiii. As per claim 57-58, line 1, it is unclear if “An e-mail system” refers to “An e-mail system” in claim 56, line 1 [i.e. if they are the same, then “The e-mail system” must be used].

Claim Rejections – 35 USC 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the

reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-2, 5, 8-11 14, 17-18, 28-29, 32, 35-36, 46-47, 50 and 53-57 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomkow, U.S. Patent Application Publication, 2002/0144154 (hereinafter Tomkow).

6. As per claims 1-2, Tomkow taught the invention as claimed comprising the steps of: receiving E-mail that contains image information (page 11, paragraph 200; page 17, paragraph 317)(e.g. attachments of various type of files) (i.e. it is inherent that attachment can include file such as image file) and includes a request for a receipt acknowledgement, said E-mail being sent from a mail sender (page 8, paragraph 135); decoding said image information contained in said E-mail (page 8, paragraph 147); creating a return mail for acknowledging a receipt of said electronic mail (page 9, paragraph 155); attaching a predetermined page (Note that it is inherent that attachment can contain one, e.g. first page, or more page.) of said image information to said return mail (page 10, paragraphs 170, 189; page 13, paragraph 251); and transmitting said return mail back to said mail sender as a response to said request (page 9, paragraph 157; page 10, paragraph 187).

7. As per claims 10-11, Tomkow taught the invention as claimed comprising the steps of:

transmitting E-mail to a mail recipient, said E-mail containing image information (e.g. attachments of various type of files) (i.e. it is inherent that attachment can include file such as image file) and including a request for a receipt acknowledgement (page 8, paragraph 135; page 11, paragraph 200; page 17, paragraph 317); receiving a return mail from said mail recipient for acknowledging a receipt of said E-mail, said return mail including a predetermined page (Note that it is inherent that attachment can contain one, e.g. first page, or more page.) of said image information contained in said E-mail (page 9, paragraph 157; page 10, paragraphs 170, 187); and outputting a status report (e.g. generating a report) indicating contents of said return mail and including an image of said predetermined page included in said image information (page 15, paragraph 296).

8. As per claims 28-29 and 46-47, Tomkow taught the invention as claimed comprising: a communications mechanism arranged and configured to transmit E-mail to a mail recipient and to receive a return mail from said mail recipient for acknowledging a receipt of said E-mail (page 8, paragraph 135), said E-mail containing image information and including a request for a receipt acknowledgement (page 11, paragraph 200; page 17, paragraph 317) (e.g. attachments of various type of files) (i.e. it is inherent that attachment can include file such as image file), and said return mail including a predetermined page of said image information contained in said E-mail (page 10, paragraphs 170, 189; page 13, paragraph 251);

an outputting mechanism (e.g. generating a report) arranged and configured to output information (page 15, paragraph 296); and

a controller arranged and configured to create said E-mail (page 11, paragraph 200; page 17, paragraph 317), and to retrieve said predetermined page (page 8, paragraph 147) and to cause said outputting mechanism (e.g. generating a report) to output a status report indicating contents of said return mail and an image of said retrieved predetermined page when said communications mechanism receives said return mail (page 15, paragraph 296).

9. As per claim 55, Tomkow taught the invention as claimed comprising:

a sending facility coupled with a communications network to which a number of receiving facilities are also coupled (page 1, paragraphs 10-13);

said sending facility being configured to assemble an e-mail message that contains non-image information including a request for an acknowledgment, and image information, and to transmit the assembled e-mail message to a selected one of said receiving facilities (page 1, paragraphs 10-13; page 11, paragraph 200; page 17, paragraph 317);

said sending facility being further configured to receive a response e-mail message from said selected receiving facility, said response e-mail message containing both non-image information and image information corresponding to at least at part of the image information sent to the receiving facility from the sending facility (page 9, paragraph 157; page 10, paragraphs 170, 189); and

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an output system coupled to said sending facility and responsive to said response e-mail message to automatically assemble and provide a visual output of a status report related to said response e-mail message, said visual output corresponding to at least a part of the image information included in the response e-mail message (page 15, paragraph 295-296).

10. As per claim 56, Tomkow taught the invention as claimed comprising:
a receiving facility coupled with a communications network to which a sending facility is also coupled (page 1, paragraphs 10-13);
said receiving facility being configured to receive an incoming e-mail message over said network from said sending facility, said received e-mail message containing a request for an acknowledgment and both non-image information and image information (page 11, paragraph 200; page 17, paragraph 317; page 8, paragraph 135);
said receiving facility being further configured to automatically assemble a response e-mail message that contains both non-image information and image information corresponding to at least a selected part of the image information included in the received e-mail message (page 9, paragraph 157; page 10, paragraphs 170, 189); and
an output system coupled to said receiving facility and configured to automatically send said response e-mail message to said sending facility over said network (page 9, paragraph 157; page 10, paragraph 187).

11. As per claims 5, 14, 32 and 50, Tomkow taught the invention as claimed in claims 1, 10, 28 and 46 above. Tomkow further taught wherein said request included in said E-mail requests a DSN (page 8, paragraph 135), said receiving step receives said E-mail according to an SMTP procedure, and said transmitting step transmits said return mail according to an SMTP procedure (pages 16-17, paragraph 316).

12. As per claims 8, 17, 35 and 53, Tomkow taught the invention as claimed in claims 1, 10, 28 and 46 above. Tomkow further taught wherein said predetermined page of said image information attached to said return mail corresponds to a number of a page designated by said request included in said E-mail (page 10, paragraphs 170, 189). (i.e. since the attachment with said return mail is a copy of the attachment originally sent by the sender requesting for a return mail, therefore, a number of a page (e.g. page number) of the attachment sent with the e-mail including the request for return mail must correspond to the number of a page in the return mail.)

13. As per claims 9, 18, 36 and 54, Tomkow taught the invention as claimed in claims 1, 10, 28 and 46 above. Tomkow further taught wherein said predetermined page of said image information attached to said return mail corresponds to a number of a page designated by said mail sender (page 10, paragraphs 170, 189). (i.e. since the attachment with said return mail is a copy of the attachment originally sent by the sender requesting for a return mail, therefore, a number of a page (e.g. page number) of the attachment sent with the e-mail including the request for return mail must correspond to the number of a page in the return mail.) through an SMTP procedure for said E-mail (pages 2-3, paragraph 21; page 16-17, paragraph 316).

14. As per claim 57, Tomkow taught the invention as claimed in claim 56 above. Tomkow further taught in which said receiving facility includes a decoding system configured to decode said image information included in the incoming message (page 8, paragraph 147) and to include in said response e-mail message only image information corresponding to a selected page of the image information (page 10, paragraphs 170, 189). (i.e. since the attachment with said return mail is a copy of the attachment originally sent by the sender requesting for a return mail, therefore, a number of a page (e.g. page number) of the attachment sent with the e-mail including the request for return mail must correspond to the number of a page in the return mail.)

Claim Rejections – 35 USC 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 3, 6-7, 12, 15-16, 19-21, 23-27, 30, 33-34, 37-39, 41-45, 48, 51-52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow in view of "Official Notice".

17. As per claims 19-20 and 37-38, Tomkow taught the invention substantially as claimed comprising:

a communications mechanism arranged and configured to receive E-mail that contains image information (e.g. attachments of various type of files) (i.e. it is inherent that attachment can include file such as image file) and includes a request for a receipt acknowledgement, said E-mail being sent from a mail sender (page 8, paragraph 135); a decoder decoding said image information contained in said E-mail (page 8, paragraph 147); and

a controller arranged and configured to create a return mail for acknowledging a receipt of said electronic mail (page 9, paragraph 155), to attach a predetermined page (Note that it is inherent that attachment can contain one, e.g. first page, or more page.) of said image information to said return mail (page 10, paragraphs 170, 189; page 13, paragraph 251), and to cause said communications mechanism to transmit said return mail back to said mail sender as a response to said request (page 9, paragraph 157; page 10, paragraph 187).

18. Tomkow did not teach a local area network. "Official Notice" is taken that the concept of E-mail sent from a sender through a local area network" is known and expected in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include E-mail sent through a local area network because by doing so it would increase the efficiency to allow users within a local area network to exchange message.

19. As per claims 3, 12, 21, 30, 39, 48 and 58, although Tomkow taught wherein said attaching step attaches said E-mail as it is to said return mail (page 10, paragraph 170, 189) and decoding step can decode said image information (page 16, paragraphs 308-309), Tomkow, however, did not specifically teach attaching said E-mail as it is to said return mail when said image information cannot be decoded. "Official Notice" is taken that the concept of attaching said E-mail as it is to said return mail and decoding step can decode said image information are known and expected in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include attaching said E-mail as it is to said return mail when said image information cannot be decode because by doing so it would increase alertness of the sender by notifying the sender of the delivery status of the E-mail.

20. As per claims 6-7, 15-16, 24-25, 33-34, 42-43 and 51-52, although Tomkow taught comprising a step of embedding a number of said predetermined page (page 10, paragraphs 170, 189) with said return mail, Tomkow, however, did not specifically detailing embedding into a first or second part of said return mail. "Official Notice" is taken that the concept of embedding into a first or second part of said return mail is known and expected in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include embedding data into a first or second part because by doing so it would increase the user flexibility by allowing a user to embed data into different parts of the return mail according to the design choice of the user.

21. As per claims 23 and 41, Tomkow taught the invention substantially as claimed in claims 19 and 37 above. Tomkow further taught wherein said request included in said E-mail requests a DSN (page 8, paragraph 135), said receiving step receives said E-mail according to an SMTP procedure, and said transmitting step transmits said return mail according to an SMTP procedure (pages 16-17, paragraph 316).

22. As per claims 26 and 44, Tomkow taught the invention substantially as claimed in claims 19 and 37 above. Tomkow further taught wherein said predetermined page of said image information attached to said return mail corresponds to a number of a page designated by said request included in said E-mail (page 10, paragraphs 170, 189). (i.e. since the attachment with said return mail is a copy of the attachment originally sent by the sender requesting for a return mail, therefore, a number of a page (e.g. page number) of the attachment sent with the e-mail including the request for return mail must correspond to the number of a page in the return mail.)

23. As per claims 27 and 45, Tomkow taught the invention substantially as claimed in claims 19 and 37 above. Tomkow further taught wherein said predetermined page of said image information attached to said return mail corresponds to a number of a page designated by said mail sender (page 10, paragraphs 170, 189). (i.e. since the attachment with said return mail is a copy of the attachment originally sent by the sender requesting for a return mail, therefore, a number of a page (e.g. page number) of the attachment sent with the e-mail including the request

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for return mail must correspond to the number of a page in the return mail.) through an SMTP procedure for said E-mail (pages 2-3, paragraph 21; page 16-17, paragraph 316).

24. Claims 4, 13, 31 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow in view of Eguchi, U.S. Patent Application Publication 2001/0005268 (hereinafter Eguchi).

25. As per claims 4, 13, 31 and 49, Tomkow taught the invention as claimed in claims 1, 10, 28 and 46 above. Although Tomkow taught said receiving step receives said E-mail according to a POP3 or an IMAP4 procedure, and said transmitting step transmits said return mail according to an SMTP procedure (pages 16-17, paragraph 316), Tomkow, however, did not teach a MDN request. Eguchi taught a similar system wherein said request included in said E-mail requests an MDN (page 1, paragraph 8).

26. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Tomkow and Eguchi because Eguchi's teaching of a MDN request would increase the sender flexibility by allowing a sender an optional function of receiving a return e-mail that notifies reception of the e-mail with either a MDN or DSN request (page 1, paragraph 8).

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27. Claims 22 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow in view of "Official Notice" as applied in claims 19 and 37, and further in view of Eguchi.

28. As per claims 22 and 40, Tomkow taught the invention substantially as claimed in claims 19 and 37 above. Although Tomkow taught said receiving step receives said E-mail according to a POP3 or an IMAP4 procedure, and said transmitting step transmits said return mail according to an SMTP procedure (pages 16-17, paragraph 316), Tomkow, however, did not teach a MDN request. Eguchi taught a similar system wherein said request included in said E-mail requests an MDN (page 1, paragraph 8).

29. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Tomkow and Eguchi because Eguchi's teaching of a MDN request would increase the sender flexibility by allowing a sender an optional function of receiving a return e-mail that notifies reception of the e-mail with either a MDN or a DSN request (page 1, paragraph 8).

CONCLUSION

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Iwazaki, U.S. Patent 6,687,742, disclosed a method for sending an E-mail with an image file and a request for acknowledgment.

Wing, U.S. Patent 6,650,440, disclosed a system for sending an E-mail with an attached fax message and a request for acknowledgment.

31. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (571)272-3967. The examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

P.L.

A handwritten signature in black ink, appearing to read "N. E. Hardy", with a long, sweeping vertical stroke extending downwards from the end of the name.